

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 1-27 will be pending, claims 1, 10, and 22 being independent.

Summary of the Office Action

Claims 1-8 are rejected as being based upon a disclosure that fails to comply with the enablement requirement of 35 USC §112, first paragraph, as stated on pages 2 and 3 of the Office action.

Claims 1-6 and 8 are rejected under 35 USC §102(b) as being anticipated by NEWMAN (U.S. Patent No. 5,210,877), as stated on page 3 of the Office action.

Claim 7 is rejected under 35 USC §103(a) over NEWMAN in view of ORIMA et al. (U.S. Patent No. 5,405,644), as stated on page 4 of the Office action.

Response to the Office Action**A. Withdrawal of Rejection Under 35 USC §112, First Paragraph**

Applicants kindly request that the rejection of claims 1-8 under 35 USC §112, first paragraph, be withdrawn.

In this ground of rejection, the Examiner has taken the position that certain ones of Applicants' claims include limitations that are not supported by a disclosure that is adequate for one of ordinary skill to make and use the invention.

The Manual of Patent Examining Procedure (MPEP), Section §2164.04, entitled "Burden on the Examiner Under the Enablement Requirement," quotes from *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 370 (CCPA 1971), in explaining that:

A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the

subject matter sought to be patented *must* be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (Emphasis in original.)

Accord, In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. Further, as explained by the court , and quoted in the aforementioned MPEP section:

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

No such explanation regarding doubting the truth or accuracy of any disclosure of Applicants has been made in the Office action and, accordingly, Applicants submit that the rejection fails to meet the burden for making a rejection for non-enablement.

Likewise, as stated in *In re Angstadt and Griffin*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976):

the PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling. In *re Armbruster*, 512 F.2d 676, 185 USPQ 152 (Cust. & Pat. App. 1975). Showing that the disclosure entails undue experimentation is part of the PTO's initial burden under *Armbruster*

Accord, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this regard as well, no showing is made in the Office action as to why undue experimentation would be needed to enable the claimed invention.

Further, the first paragraph of 35 USC §112 requires that an applicant's/patentee's disclosure must enable a person skilled in the art to make and use the claimed invention.

"Patents *** are written to enable those skilled in the art to practice the invention." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983, *cert. denied*, 469 U.S. 851 (1984)).

Regarding this latter point, the instant application is not directed to new materials or new fibers, *per se*, or to hydrophilic or antibacterial treatments. The invention encompasses the use of materials, fibers, and/or treatments in a unique combination/arrangement in a single garment. The disclosure of materials, fibers and/or treatments that are specified in certain claims are known to those skilled in the art of garments and, to this extent, the citation of same in the claims is commensurate in scope with the disclosure. Examples of such materials, fibers, and treatments are attached and are mentioned below.

Therefore, for that reason and for the reason that the Office action lacks a showing regarding why undue experimentation would be required for making or using the claimed invention, the Office action fails to present a *prima facie* case of non-enablement. Accordingly, Applicants request that the rejection be reconsidered and withdrawn.

Nevertheless, Applicants will next respond to certain issues raised by the Examiner in the rejection.

Four limitations in the rejected claims are cited as giving rise to the rejection:

- (a) material resistant to abrasion (claim 1)
- (b) material treated for transferring moisture from the inner to the outer surface of the garment (claim 4)
- (c) material having an antibacterial treatment (claim 6) and/or silver threads (claim 7)
- (d) material having perspiration draining and evacuation capabilities (claim 8)

Applicants will comment on these issues in seriatim immediately below.

(a) Material resistant to abrasion (claim 1)

Regarding claim 1, the examiner comments that "... it is not clear as to what type of 'abrasion resistant material' is used or how it is abrasion resistant or as to what degree it is abrasion resistant."

The detailed description of the instant application includes the following. The abrasion-resistant material of the section 21, 11 (on the back and shoulders, respectively) is described as being "made of a woven material that is more resistant to abrasion" in paragraph 0026. Paragraph 0016 explains that woven materials are more resistant to abrasion than jersey materials (such as used in a cotton T-shirt) due to their woven structure. In addition, in paragraph 0031, a specific example of a suitable woven material is given as "a fabric made of 86% polyester (PES) and 14% elasthane, with a density of 140 g/m²."

Thus, far from not making clear the type of abrasion resistant material that is encompassed by the invention, Applicants provide concrete examples of such material, *i.e.*, woven materials in general, those comprising a majority or a blend of polyester fibers in more detail, and those in which the woven fabric is made of 86% polyester and 14% elasthane having a density of 140 g/m² in still greater detail.

The answer to the second of the Examiner's questions, *i.e.*, "how it is abrasion resistant," is also well presented in Applicants' original disclosure. The material is abrasion resistant by reducing the ability of the garment to abrade from the friction of a backpack, for example, rubbing along its surface as mentioned, *e.g.*, in paragraph 0014 of the specification of the instant application.

Finally, the answer to the third of the Examiner's questions, relating "to what degree it is abrasion resistant," is also provided in the specification. Of course, the question is not seen

relevant to the rejection, particularly since the claims are commensurate in scope with the disclosure in this regard. Nevertheless, the material is abrasion resistant at least to the extent that it is more abrasion resistant than cotton jersey material as used in a common T-shirt (note paragraphs 0006 and 0014, for example). This description is commensurate in scope with the limitation in the claims, as well.

(b) Material treated for transferring moisture from the inner to the outer surface (claim 4)

Regarding claim 4, the Examiner comments that it is not clear from the specification how the material is treated so as to be hydrophilic.

As mentioned above, the particulars of the treatment of the abrasion-resistant material, as specified in claim 4, is not new, *per se*. Instead, claim 4 relates to the application of a moisture-transferring treatment for the aforementioned abrasion-resistant material.

Such treatment had been known at the time of the invention. In this regard, **Attachment A** includes several pages from a publication (bilingual, French/English) entitled *TechStyle, the Guide to Activewear Fibres and Fabrics*. Specifically, the following are included: the cover page, page 5 (from the table of contents), page 7 (from the Fabric Index, listing numerous hydrophilic or microporous materials), page 86 (describing the details of Sympatex®, from the Guide to Fibers and Fabrics, Sympatex® being one example of a hydrophilic polyester material listed on page 7, although not that this material would be used necessarily in Applicants' invention), and page 43 (from a section entitled "Comparing systems," which describes hydrophilic membranes).

In addition, **Attachment B** includes several articles downloaded from various sites on the Internet that describe hydrophilic treatments, particularly for polyester materials.

(c) Material having an antibacterial treatment and silver threads (claims 6, 7)

Regarding claims 6 and 7, the Examiner comments that the "antibacterial treatment" has not been clearly described and that the specification only states that silver threads are added in one example. In addition, the Examiner comments that the amount necessary to perform the antibacterial treatment has not been described.

Applicants disagree. In paragraph 0036, the specification describes the material 41 of the garment as having undergone an antibacterial treatment and/or is provided with silver threads. Paragraph 0037 gives an example of such material as X-STATIC®.

Again with reference to the *TechStyle* guide, **Attachment C** is a copy of page 97 thereof, which provides a detailed description of the properties of X-STATIC®. As an example, it is there explained that the amount of silver is generally about 15% and that 99.9% of bacteria is eliminated in one hour of exposure. Accordingly, one skilled in the art would have had adequate knowledge how to make and use the invention. Further, claims 6 and 7 are commensurate in scope with the disclosure.

(d) Material with perspiration draining and evacuation capabilities (claim 8)

Regarding claim 8, the Examiner comments that it is not clear from the specification how or what makes the material have perspiration draining and evacuation capabilities.

Claim 8 merely specifies that "other portions of the garment" (*i.e.*, other than the abrasion-resistant section), "are made of a material having perspiration draining and evacuation capabilities."

In paragraph 0039 of the specification, Applicants explain that these "other portions" can be the same material (*i.e.*, but not necessarily the same material) as that of the abrasion-resistant section. For example, they could be both be woven polyester materials, which repels

water/moisture toward the outside of the garment (therefore exhibiting perspiration draining and evacuation properties), and these "other portions" of claim 8 could also have an additional hydrophilic treatment to further enhance the transfer of moisture.

Again, as with Applicants' a detailed example relating to the disclosure of an antibacterial treatment, in paragraph 0040 of their specification, Applicants have provided a detailed example of a material relating to claim 8. That is, paragraph 0040 describes such example as a jersey material made of 100% PES (polyester) and having a density of 135 g/m².

B. Withdrawal of Rejections Based Upon NEWMAN

Applicants request reconsideration and withdrawal of the rejection of claims 1-6 and 8 under 35 USC §102(b) as being anticipated by NEWMAN (U.S. Patent No. 5,210,877), and reconsideration and withdrawal of the rejection of claim 7 under 35 USC §103(a) as unpatentable over NEWMAN in view of ORIMA (U.S. Patent No. 6,374,643).

NEWMAN discloses a garment, such as a jersey, to be worn by a bicyclist, the jersey providing abrasion resistance in the event the bicyclist were to fall onto the pavement. The material disclosed by NEWMAN in column 2, in the summary section of the patent, is SPECTRA or other "high performance fibers or yarn". Several different types of fiber are specified in column 2, lines 10-16, including woven polyester.

Examples are illustrated in which the abrasion-resistant material is located in the areas of the shoulders, the *sleeves*, and the *upper* back. In column 3, lines 17-19, NEWMAN explains that "the balance of the garment is constructed with conventional fabric used for bicycle jerseys."

There are at least two significant differences between Applicants' claimed invention and the disclosure of NEWMAN.

First, NEWMAN's disclosure is specifically related to the protection of areas of a person's body in the event of a fall from a bicycle. By contrast, Applicants' invention is specifically related to the protection of specific areas of a garment that need to be protected against abrasions that would occur in areas in which a backpack would rub.

Second, in NEWMAN the abrasion-resistant are located in the areas of the shoulder, the sleeves and a limited portion of the upper back. There is no need for NEWMAN, in meeting the objectives of his invention, to extend the abrasion-resistant sections downwardly through a majority of the back (where a backpack might otherwise abrade against the back) and, certainly, not to extend downwardly through the entirety of the back. All of independent claims 1, 10, and 22 refer to the abrasion-resistant material extending to cover a majority of the wearer's back, and dependent claims 9, 16, and 27 (depending from claims 1, 10, and 22, respectively, refer to the abrasion-resistant material extending downwardly over the wearer's back through the entire length of the garment.

In the amendment above, Applicants have replaced the word "yoke" with the word "section" in referring to the part of the garment that provides abrasion-resistance for the purpose of avoiding any interpretation of the term "yoke" as referring to merely a shoulder zone. As has been made clear in the disclosure, as filed, the abrasion-resistant area, such as section 21 in Fig. 2, is to extend downwardly from the shoulders to the areas that would possibly come in contact with a backpack when worn by the wearer of the garment.

At least for the foregoing reasons, reconsideration and withdrawal of the rejections based upon NEWMAN, solely or primarily, are kindly requested.

C. New Claims

New claims 9-27 have been added. Claims 9, 10, 16, 22, and 27 have been mentioned above.

Claim 11 depends from independent claim 10 and specifies that at least a part of the sleeves are "distinct from said body portion" of the garment. For example, as can be seen in Figs. 1 and 2, the upper parts 31 of the sleeves are separate from and are stitched to the lower parts 41.

Claim 12 depends from claim 10 and specifies that the abrasion-resistant material comprises polyester, claim 13 specifies that the abrasion-resistant material comprises a woven material, and claim 14 specifies that the abrasion-resistant material comprises a material having woven polyester fibers.

Claim 15 depends from claim 10 and specifies that the section of said body portion adapted to cover a majority of a wearer's back and at least a portion of a shoulder area of the wearer comprises a section adapted to extend downwardly from the shoulder area through a majority of the *length* of the garment. As explained above, in NEWMAN the material 8 is applied only on the uppermost part of the back to protect the part of the back would likely contact the pavement upon the fall of a bicyclist

Claim 16, similar to claim 15, but specifies that the section of said body portion adapted to cover a majority of a wearer's back and at least a portion of a shoulder area of the wearer extends downwardly from the shoulder area through *the entire length of the garment*.

Claim 17 depends from claim 10 and specifies that the sleeves are *not* made of abrasion-

resistant material. This would be contrary to NEWMAN which has the sleeves made from such material. To remove it would be counter to the teachings of NEWMAN.

Claim 18 depends from claim 10 and further specifies that the abrasion-resistant material further comprises a hydrophilic treatment.

Claim 19 depends from claim 10 and specifies that the garment comprises arm sections adapted to extend along the sleeves, beneath at least a portion of the wearer's arms and at least a portion of a torso of the wearer, the arm sections comprising an aerated material. These sections correspond, for example, to sections 41 in Figs. 1 and 2.

Claim 20 depends from claim 19 and further specifies that the arm sections further comprise an antibacterial treatment.

Claim 21, like claim 20, depends from claim 19 and further specifies that the arm sections comprise antibacterial fibers.

Independent claim 22 describes the garment of the invention in considerable detail. For example, claim 22 describes the garment of the invention as comprising at least three materials that make up different respective locations of the garment. The first material is to cover at least a majority of the wearer's back and at least a portion of the shoulders.

The second material covers the front of the wearer's torso, the third material which comprise at least parts of the sleeves, and the second and third materials are different from the first material.

The first material is described as being an abrasion-resistant material, whereas the second material is described as being an aerated material.

Claim 23 depends from claim 22 and further specifies that the third material is an aerated material.

Claim 24 depends from claim 23 and further specifies that the third material is an aerated material having an antibacterial treatment.

Claim 25 depends from claim 22 and specifies that the first material comprises a woven material.

Claim 26 depends from claim 22 and specifies that the first material comprises a woven material including polyester fibers.

Claim 27 depends from claim 22 and specifies that the first material of the one section of the body portion extends downwardly from the shoulder area through the *entire length* of the garment.

SUMMARY AND CONCLUSION

The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.


A check is enclosed for payment of a claim fee and a fee for an extension of time for one month. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an additional extension of time were necessary to render

this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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